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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/501,676  
Filing Date: February 22, 2005  
Appellant(s): SKAUG, TERJE

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Keith R. Obert  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/25/2010 appealing from the Office action mailed 03/25/2010.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

U.S. Patent No. 6,909,906	Miyashita	06-2005
U.S. Patent No. 6,201,534	Steele	03-2001
U.S. Pub. No. 2003/0016417	Lee	01-2003

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 and 10-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyashita (U.S. Patent No. 6,909,906) in view of Steele (U.S. Patent No. 6,201,534), and in further view of Lee (U.S. Appl. Publ. No. 2003/0016417).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyashita (U.S. Patent No. 6,909,906) in view of Steele (U.S. Patent No. 6,201,534), and further in view of Lee (U.S. Pub. No. 2003/0016417).

**As to claim 1**, Miyashita teaches an apparatus (100, which is a device for communication), comprising:

an already existing electronic communication or player device having a screen display (the existing electronic communication or player communication or player device has a display screen 101), and

one or more pointing device components integrated into the already existing electronic communication or player device (the pointing device 105 is added to the existing electronic communication or player device 100),

wherein said one or more pointing device components are configured to give the already existing electronic communication or player device, in addition to its main functions (the already existing electronic communication or player devices main function is a mobile telephone, col. 5 lines 2-7),

an auxiliary function as a pointing device (the auxiliary function is the mouse functionality of 105, col. 5, lines 8-11),

Miyashita does not mention the already existing electronic communication or player device to act together with an external electronic communication or player screen device and an auxiliary function as a pointing device with respect to the external electronic screen display device. Steele teaches the already existing electronic communication or player device (400a) to act together with an external electronic communication or player screen device (416a), (col. 6, lines 48-49) and wherein the external electronic communication or player screen device is other than the screen display of the already existing electronic communication or player device. (the screen 101 on Miyashita's is different than the screen 416a in Steele because one is attached to the already existing electronic communication or player device and the other is not attached to the already existing electronic communication or player device and is considered an external display screen).

Steele also teaches an auxiliary function as a pointing device with respect to an external electronic screen display device (the electronic device functions as a remote control and also functions as a pointing device with respect to an external electronic screen display device 416a as can be seen in fig. 6A)

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the remote control system 400a of Steele to the telephone set main body of Miyashita which will result in a useful and tangible result, wherein the user can use the same device for multiple usage such as a telephone and a cursor positioning device to select an item on the view screen.

Miyashita and Steele do not mention the pointing device being configured to operate independent of a functionality of the existing electronic communication or player device.

Lee teaches the pointing device (laser pointer) being configured to operate independent of a functionality of the existing electronic communication or player device (mouse, wherein the casing 2 is considered a generic optical mouse [0031], lines 2-3), (the laser guiding device can fit on an end face of the device wherein the ON/OFF is controlled by a push button switch, wherein the functionality of the laser is separate from the functionality of the mouse ([0014])). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the laser guided device separate from the functionality of the mouse of Lee to the apparatus of Miyashita as modified by Steele because to provide a wireless pointing and remote

Art Unit: 2629

controlling device for briefing, which may cooperate with a conventional laser-guiding device for aiding a briefing operation ([0009]).

**As to claim 2**, Miyashita does not mention an optical or radio transmission connection with the external electronic communication or player device. Steele teaches the already existing electronic communication or player device (400a) comprises optical or radio transmission means configured to establish a wireless connection with the external electronic screen display device or player screen device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

**As to claim 3**, Steele teaches the one or more pointing device (there is one element, 400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).

**As to claim 4**, Miyashita teaches the one or more pointing device components (109, 107, and 108) are integrated in an auxiliary unit (105), said auxiliary unit is releasably mounted to the already existing electronic communication or player device (as can be seen in Fig. 2 the auxiliary unit is releasable from the already existing electronic communication or player device 100 by portions 125 and 126, col. 7, lines 5-9) in such a manner that the auxiliary unit can be released and act as a-the pointing device separately from the already existing electronic communication or player device

Art Unit: 2629

(as can be seen in Fig. 2 the auxiliary unit 105 is separated from the already existing electronic communication or player device 100 and is used as a mouse).

**As to claim 5**, Steele teaches the auxiliary unit further comprises optical or radio transmission means (infrared connection), said optical or radio transmission means is configured to establish a wireless connection with the external electronic screen display device (col. 6, lines 53-56), (the remote control and external screen are connected with an infrared signal).

**As to claim 6**, Miyashita teaches the auxiliary unit is a battery pack of the already existing electronic communication or player device (col. 6, lines 9-12).

**As to claim 10**, Miyashita teaches the already existing electronic communication or player device (100) is one of the following devices: a mobile telephone, a personal data assistant, a digital audio player and a minidisk player (device 100 is a mobile telephone).

**As to claim 11**, Steele teaches the one or more pointing device (400a) components comprise at least one of the following components:

a mechanical or optical reader, a button element and a scroll wheel (108a and 106a).



**As to claim 12**, Miyashita teaches the one or more pointing device components (109, 108, and 107) are configured in a body of the already existing electronic communication or player device (the components 107-109 are configured in the already existing electronic communication or player device 100 via 105) in such a manner that the body is suitable for contact with a user's palm (It can be seen in Fig. 1 that the mobile telephone device is used by a user and requires a user to use the telephone with his/her hand).

**As to claim 13**, Miyashita teaches the one or more pointing device components (107-109) are configured to perform functionality of a mouse unit (col. 6, lines 8-11).

**As to claim 14**, Miyashita teaches the one or more pointing device components (107-109) are configured in a body of the already existing electronic communication or player device (the components are configured in the already existing electronic communication or player device 100 via 105) in such a manner that the body appears to a user like a body of a mouse unit (the body 105 configured in the already existing electronic communication or player device 100 is a mouse having left and right buttons 107 and 108 and rotary wheel 109).

## **(10) Response to Argument**

### **Issue 1:**

Appellant argues that claim 1 is not disclosed or suggested by the cited references, alone or in combination, because the cited references fail to disclose or

Art Unit: 2629

suggest all of the limitations recited in claim 1. Appellant respectfully submits that the cited references, alone or in combination, at least fail to disclose or suggest that the one or more pointing device components are configured to give the already existing electronic communication or player device, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device, thus enabling the already existing electronic communication or player device to act together with the external electronic screen display device, and the external electronic screen display device is other than the screen display of the already existing electronic communication or player device, as recited in claim 1.

Examiner respectfully disagrees because the prior art references of Miyashita and Steele clearly teach the above mentioned limitation(s) for the reason(s) below:

Applicant in claim 1 claims "one or more pointing device components", this limitation could be interpreted as "one pointing device component" because of the "or" between the terms "one" and "more".

Thus, Miyashita teaches pointing device 105, which has a track ball 131 acts as "one pointing device component" of already existing electronic device communication device, which is a mobile telephone. The pointing device 105 in addition to give the mobile telephone its main functionality, which is using the keypads to dial a number, an auxiliary function as a pointing device, which is the mouse functionality of the pointing device 105 to move a cursor on the display of the mobile telephone.

Miyashita does not mention existing electronic communication or player device to act together with an external electronic communication or player screen device.

The prior art reference of Steele clearly teaches this limitation(s) wherein the existing electronic communication of Steele, 400a, is similar to mobile telephone of Miyashita wherein both have keypads and both have “one pointing device component”, which is the pointing device 108a. Steele teaches the already existing electronic communication device 400a acts together with an external electronic communication or player screen device 416a, wherein screen 416a is different than the screen display of the already existing electronic communication or player device. The already existing electronic communication of Steele functions as a remote control and the track ball 108a, which is the “one pointing device component” functions as a pointing device with respect to an external electronic screen display device 416a, wherein the pointing device component controls a cursor 419a on the screen 416a. Therefore the remote control system 400a of Steele has been added to the mobile telephone of Miyashita, wherein the user can use the mobile telephone for multiple usage such as a main functionality of dialing with the mobile phone and auxiliary functionality of controlling a cursor on an external electronic communication screen device.

Appellant argues that Miyashita does not disclose that the already existing electronic communication device or player device acts together with the external electronic screen display device, and relies upon Steele for this teaching. However, applicant respectfully submits that Steele also fails to disclose or suggest that an already existing electronic communication or player device acts together with an external electronic screen display device, where the external electronic screen display

Art Unit: 2629

device is other than the screen display of the already existing electronic communication or player device, as recited in claim 1.

Appellant further mentions The Office asserts that video monitor (416a) of Figure 6A of Steele corresponds to the external electronic screen display device, as recited in claim 1. However, the video monitor (416a) is part of the remote control system (400a) that includes the electronic controller (414a) and the video monitor (416a). See Steele column 6, lines 41-44. Therefore, the video monitor (416a) of Steele cannot be the external electronic screen display device of claim 1, because it is at most the screen display of the already existing electronic communication or player device, since the remote controller (414a) does not include a display screen of its own.

Examiner respectfully disagrees with the Appellant because Miyashita teaches an already existing electronic communication device wherein this device has a display screen and the "one pointing device component" controls a cursor on the display screen of the already existing electronic communication device. Miyashita does not mention the "one pointing device component" is able to control an external display screen. Therefore examiner has combined the prior art reference of Steele with Miyashita. Steele teaches an already existing electronic communication device wherein the "one pointing device component" controls a cursor on an external display screen, which is not attached to the already existing electronic communication device.

The limitation of "external electronic screen display device" means a display screen located outside of an electronic device. Examiner would like to point out that the Appellant has made a mistake in considering display screen 416a as part of the

Art Unit: 2629

electronic device 400a because based on the Appellant's argument that "display 416a is part of the remote controller 414a" then every display that the remote controller 414a interacts with is part of the remote controller and there would be no monitor that would fit the description of "an external screen display". Thus, examiner strongly considers the screen 416a as "an external screen display" because screen 416a is external to the electronic device.

Examiner would like to also point out that Miyashita teaches an already existing electronic communication device that has a display screen as can be seen in fig. 2. Miyashita does not mention the already existing electronic device can interact with an external display screen wherein the external electronic communication screen device is other than the screen display of the already existing electronic communication device. The prior art reference of Steele teaches an external display screen, which is located outside of the already existing electronic communication device of Steele. Therefore by combining the prior art references of Miyashita and Steele the already existing communication device of Miyashita may control a cursor on an external display screen, wherein the two "already existing electronic communication device" of Miyashita and Steele are similar wherein both have a keypad that the user can use the main functionality of the already existing electronic communication device (i.e. remote control or mobile phone) and both have "one pointing device component" to use the device in addition to its main functionality an auxiliary functionality of pointing device, which both references teach using the "one pointing device component" to control a cursor on a display screen.

Appellant further argues that claim 1 specifically states that the external electronic screen display device that is other than the screen display of the already existing electronic communication or player device.

Examiner would like to point out that the display 416a of Steele is an external electronic screen display device. The reference of Steele is combined with Miyashita's already existing electronic device that has a display screen attached to the electronic device. Therefore the external electronic display 416a is considered as "the external electronic screen display device that is other than the screen display of the already existing electronic communication or player device".

**Issue 2:**

Appellant argues that Steele would provide no motivation to provide an already existing electronic communication or player device to act together with an external electronic screen display device that is not a display screen of the already existing electronic communication or player device, since Steele only discloses one screen display. The teachings of Steele suffer from the same deficiencies, as recognized by the Office, as Miyashita with respect to the already existing electronic communication or player device acting together with an external electronic screen display device.

Examiner respectfully disagrees with the Appellant because the motivation to combine the two references has been provided in the previous office actions, wherein by combining the two references it will result in a useful and tangible device wherein the user can use the already existing electronic communication device for multiple usage

Art Unit: 2629

such as a mobile telephone and a pointing device to control a cursor on a display screen.

Appellant argues that simply because the video monitor (416a) is not physically attached to the remote controller (414a) in Steele does not mean that the video monitor (416a) corresponds to the external electronic screen display device of claim 1.

Examiner would like to point out to the limitation of “the external electronic communication or player screen device is other than the screen display of the already existing electronic communication or player device” is taught by the combination of the two references of Miyashita and Steele wherein Miyashita teaches an electronic device that the screen display is attached to the already existing electronic communication device, and by combining the reference of Steele, which teaches controlling a cursor on an external display device, the already existing electronic communication device of Miyashita may control the cursor on the display screen of the display 101 and also be able to control the cursor on the display screen that is external to the already existing electronic communication device, wherein the external display screen 416a is other than the display 101 of Miyashita.

Examiner would like to also point out that the electronic communication device of Steele may also have a screen display attached to the electronic communication device as can be seen in Fig. 1.

Appellant further argues that The Office acknowledges on page 8 of the Office Action that the remote controller (414a) does not have its own display, and merely states that because video monitor (416a) is located outside of the remote controller

Art Unit: 2629

(414a) it corresponds to the external display screen of claim 1. However, this interpretation completely ignores the limitations of claim 1 identified above, which require a screen display and an external screen display device.

Examiner respectfully disagrees about ignoring the limitations of claim 1, which require a screen display and an external screen display device.

The two references of Miyashita and Steele have been correctly combined, wherein Miyashita teaches an already existing communication device having a display screen wherein the “one pointing device component” can control a cursor on the screen attached to the device. On the other hand, Steele teaches an already existing communication device, which could have a display device (Fig. 1), controls a cursor on a display screen, which is located external to the already existing communication device. Therefore, it is clear that by combining the two references the already existing communication device of Miyashita could not only control a cursor on the display attached to the communication device, it can also control a cursor on an external display that is other than the screen display of the already existing electronic communication device. Therefore the limitations of claim 1 are not ignored and examiner would like to point out that the term “external electronic communication or player screen device” is a broad term and would include any display screen located external to the electronic communication device.

Appellant argues that there is no motivation to combine the cited references, because the combination is based on impermissible hindsight reasoning taken directly from the specification of the present application.



Examiner respectfully disagrees with the Appellant and would like to mention that the combination is a valid combination and was not taken from the specification of the present application.

Both references teach an already existing communication device, wherein one (Miyashita) has a keypad and is used as a mobile telephone and the other (Steele) has a keypad and is used as a remote control. Both references teach the already existing communication device in addition to its main function has an auxiliary function as a pointing device wherein both references have "one pointing device component", wherein by using this one pointing device component the user is able to control a cursor on a display screen. Therefore both references teach similar functionalities and by combining the two references the user is able to use the device for multiple tasks such as using the mobile phone, remote control, and controlling a cursor as a pointing device on a display screen. This combination would give the user an edge to use one device for multiple tasks and the motivation has been clearly given in the previous office actions.

Therefore for the reasons given above the prior art references of Miyashita and Steele read on the above discussed limitations of claim 1.

**Issue 3:**

Appellant argues that claim 1 requires that the already existing electronic communication or player device has, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display

Art Unit: 2629

device, thus enabling the already existing electronic communication or player device to act together with the external electronic screen display device.

Examiner has mentioned the above limitation before wherein the already existing electronic communication or player devices have a main functionality (i.e. mobile phone and remote control), which are used as a communication device have an auxiliary function of moving a cursor (pointing device) on a display screen. Therefore the already existing electronic communication device acts together with the external electronic screen to move a cursor on an external screen (416a)

Examiner would like to point out that the applicants limitation of “the pointing device being configured to operate independently of a functionality of the existing electronic communication or player device” is not clear and Examiner has interpreted this limitation of the pointing device, which is an auxiliary function is independent of the functionality of the existing electronic communication device’s main functionality.

The reason the above mentioned limitation is not clear is because Appellant in the arguments of page 6, lines 7-11 mentions “claim 1 requires that the already existing electronic communication or player device has, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device, thus enabling the already existing electronic communication or player device to **act together** with the external electronic screen display device” wherein this limitation contradicts with the limitation of “he pointing device being configured to operate independently of a functionality of the existing electronic communication or player device” because if the already existing electronic device acts together with the

Art Unit: 2629

external electronic screen display device then than means the main functionality and auxiliary functionality (pointing device) are not operating independent from each other.

Examiner has added the prior art reference of Lee to teach that a device having a main functionality (mouse) is independent of the auxiliary functionality (laser pointer) wherein the laser guide device can fit on an end face of the device wherein the ON/OFF is controlled by a push button switch, wherein the functionality of the laser is separate from the functionality of the mouse, also the user can use the mouse when the device is held in a certain way and use the laser pointer when the device is held upside down (Figs. 5 and 6). Therefore the same functionality could be used in the prior art references of Miyashita and Steele wherein the user may turn the switch ON/OFF so that either the mobile device or remote control can work as a pointing device. Therefore there is no common functionality between the two devices and the main functionality is strongly independent of the auxiliary function.

Examiner would like to point out that the prior art references of Miyashita and Steele mention the already existing electronic devices having a main functionality (i.e. mobile device and remote control) and also an auxiliary functionality (pointing device) there is no switch to switch between the main functionality and auxiliary functionality in order to make the functionalities independent from one another. Therefore the prior art reference of Lee has been added to show that the main functionality (i.e. mouse) can be switched to an auxiliary functionality (i.e. laser guide) and because of the switch the functionalities do not overlap and are independent from each other.

Appellant further argues that the projected laser beam does not enable the wireless transmission unit of Lee to act together with the computer (3) or projector (5). Instead, the laser pointing device merely acts as a pointer with respect to items on the screen (6). Lee only provides the pointer (61) that acts together with the projection screen (6) of the projector (5) in connection with the computer (3). See Lee paragraph [0028]. For at least the reasons discussed above, claim 1 is not disclosed or suggested by the cited references.

Examiner respectfully disagrees with the Appellant because the switch of Lee, which changes between the main functionality and auxiliary functionality is used to teach the main function and auxiliary function are independent from each other. Applicant in the claims does not mention how the independent functionalities work and what components are involved or not involved in the main functionality and auxiliary functionality. Examiner did not mention anything about "the projected laser beam does not enable the wireless transmission unit of Lee to act together with the computer (3) or projector (5)" because this limitation was not necessary in rejecting the limitations of claim 1 and is not relevant to overcoming the rejections.

Examiner would like to mention that the Applicant in the claims did not mention the main functionality of the already existing communication device. Therefore the main functionality of the already existing communication device of Lee could be the mouse functionality, which moves a cursor on the screen by moving a mouse on a surface (Fig. 4) and the auxiliary function is a device not attached to a surface and held in the user's

Art Unit: 2629

hand for moving a cursor on the screen (Fig. 2), which are both connected to the wireless transmission unit and work independently from each other.

Therefore the combination of the prior art references of Miyashita, Steele, and Lee clearly teach all of the limitations of claim 1 and claim 1 is disclosed or suggested by the cited references.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

/Pegeman Karimi/  
Examiner, Art Unit 2629

January 14, 2011

Conferees:

/Chanh Nguyen/  
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